UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,854	07/25/2001	Sachio Nagamitsu	MTS-3264US	6587

7590 09/08/2004

Allan Ratner
Ratner & Prestia
One Westlakes, Berwyn, Suite 301
P.O. Box 980
Valley Forge, PA 19482-0980

EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/912,854	Applicant(s) NAGAMITSU ET AL.	
	Examiner Igor Borissov	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-26 have been cancelled. Claims 27-28 have been amended. New claims 31-44 have been added. Claims 27-44 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 27, 28, 31, 32, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos (US 5,699,276) in view of Johnson (US 6,169,979).

Roos teaches a method and system for providing an interface between a digital network and home electronics, comprising:

As per claims 27 and 37, a power management means for detecting that a user is utilizing an appliance and for measuring the amount of power consumed by said appliance (column 4, line 1 – column 5, line 67; column 7, lines 2-62);

a fee charging means for charging a lower or higher fees for said measured amount of power consumed (column 4, line 1 – column 5, line 67; column 7, lines 2-62).

Roos does not teach for purchasing the appliance at a special price, wherein a part of the fee paid is allocated to the manufacturer that has sold said appliance.

Johnson teaches a method and system for a computer-assisted sales system for utilities, wherein rebates are provided for purchasing or installation more energy efficient equipment and various fees are charged for power consumed (column 2, lines 49-51; column 5, lines 1-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos to include purchasing the appliance at a special price, as disclosed in Johnson, because it would allow a customer to reduce the energy

consumption and utility cost. Information as to *the appliance provider being separate from an electric power provider* is non-functional language and given no patentable weight. A difference in ownership of financial institutions is not a practical application within the technological arts, and, therefore, is not statutory matter (MPEP 2106.IV.B.2(b) at p. 2100-15 to -18 revised May 2004). Furthermore, this limitation constitutes descriptive material that does not describe a functional interrelationship (MPEP 2106.IV.B.1(b) at pp. 2100-13 and 2100-14 revised May 2004).

As per claims 28 and 31 Roos teaches said method and system, including detecting that a user is utilizing an appliance, and charging lower of higher fees for measured amount of power consumed (column 4, line 1 – column 5, line 67; column 7, lines 2-62).

Johnson teaches said method and system, wherein rebates are provided for purchasing or installation more energy efficient equipment and various fees are charged for power consumed (column 2, lines 49-51; column 5, lines 1-24).

The motivation to combine Roos and Johnson would be stimulating a customer to reduce the energy consumption and utility cost.

As per claim 32, Johnson teaches purchasing or installation more energy efficient equipment (column 2, lines 49-51; column 5, lines 1-24), thereby obviously indicating operating the appliance in an energy saving mode. The motivation to combine Roos and Johnson would be stimulating a customer to reduce the energy consumption and utility cost.

As per claim 43, Roos teaches said method and system, comprising a display means installed in the home of said user, which receives said measurement information prepared by said automatic measurement means and which displays the fee (column 5, lines 30-43).

Claims 29, 33-36, 38-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roos in view of Johnson and further in view of Yablonowski et al. (US 6,535,859).

As per claims 29, 33 and 39, Roos in view of Johnson teach all the limitations of claim 28, except providing a portion of said calculated fee charged to the installer of the power measurement unit/controller.

Yablonowski et al. teach a method and system for charging a fee to an end user, wherein a power saving device is retrofitted into a user's facility, and a portion of the calculated fee charged is provided to an installer of the power measurement unit/controller (column 7, lines 2 – column 8, line 65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos in view of Johnson to include that a portion of the calculated fee charged is provided to an installer of the power measurement unit, as disclosed in Yablonowski et al., because it would allow to pay installer for the job done.

As per claims 34-36 and 40-42, Roos in view of Johnson teach all the limitations of claim 28, except that the additional fee is determined based on information concerning the degree of energy savings resulted from using said appliance.

Yablonowski et al. teach said method and system for charging a fee to an end user, wherein a power saving device is retrofitted into a user's facility, and fee charged are calculated as a function of a difference between the original power consumption and the new power consumption (column 7, line 2 – column 8, line 65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos and Johnson to include that the additional fee is determined based on information concerning the degree of energy savings resulted from using said appliance, because it would stimulate a customer to reduce the energy consumption and utility cost.

As per claim 38, Yablonowski et al. teach said method and system, comprising a power management means for detecting that a user is utilizing said mode selectable apparatus in said special price mode (column 9, line 17).

Also, as per claim 44, Yablonowski et al. teach said method and system, comprising an energy saving control means for energy saving control based on human body detection (column 6, lines 39-40).

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roos and Johnson in view of Hart et al. (US 4,858,141).

As per claim 30, Roos in view of Johnson teach all the limitations of claim 30, except that measuring the value of the electric power consumed by said appliance is conducted separately from power consumed by other appliances.

Hart et al. teach a method and system for non-intrusive appliance monitoring apparatus, wherein the power consumption of each of a plurality of appliances is monitored separately from other appliances (column 2, lines 15-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Roos in view of Johnson to include separately measuring the value of the electric power consumed by said appliance, as disclosed in Hart et al., because it would allow to monitor and demonstrate the savings of power usage by new appliance, thereby convincing the purchaser to upgrade remaining appliances.

Response to Arguments

Applicant's arguments filed 3/26/04 have been fully considered but they are not persuasive.

In response to the applicant's argument that the appliance provider and electric provider are different entities, the examiner points out that the ownership limitation is nonfunctional descriptive material, and was accordingly not given patentable weight. These limitations are descriptive material that does not describe a functional interrelationship (MPEP 2106.IV.B.1(b), first paragraph, at pp. 2100-13 and 2100-14 revised May 2004). Ownership distinctions cannot make an invention patentable. As a matter of fact, in the end, it is the customer who funds the rebate by paying higher rate for the energy. How the burden of funding the rebate is shared among the participating institutions is irrelevant to patentability.

In response to the applicant's argument that Roos and Yablonowski et al. do not teach separately measuring power consumed by said appliance, it is noted that Hart et al. was applied to show this feature. Specifically. Hart et al. teach said method and system for non-intrusive appliance monitoring apparatus, wherein the power consumption of each of a plurality of appliances is monitored separately from other appliances (column 2, lines 15-17).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

9/05/2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600